

REMARKS

Claims 1 and 3-34 are all the claims pending in the application, claim 2 having been previously cancelled and claim 34 being newly added. Claims 1 and 15 are the only independent claims. Support for the foregoing claim amendments may be found in, for example, at least in Figs. 1b and 1e-1i, and the accompanying portions of the specification. No new matter has been added.

Claims 1-25 and 27-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Armstrong (5,565,891) in view of Meriaz (U.S. Pat. Pub. 2002/0113776). Claim 26 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Armstrong and Meriaz, and further in view of Yokoji (6,909,422). Applicant respectfully traverses these rejections, and requests reconsideration and allowance of the pending claims in view of the following arguments.

Claim Rejections - 35 U.S.C. §103

Claims 1-25 and 27-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Armstrong in view of Meriaz.

Claim 1 is directed toward a user interface device and recites “signal circuitry producing an outgoing displacement signal responsive to said sensor signals and a second outgoing signal responsive to the first plurality of signals, the signal circuitry being configured to permit the production of the outgoing displacement signal and the second outgoing signal simultaneously.”

Signals produced “simultaneously”

The Office Action relies upon the combination of Armstrong and Meriaz to teach the foregoing signal circuitry feature. The point of contention relates to the signals disclosed by the Meriaz device. Applicant’s position is that Meriaz merely permits manipulation of either the trackball or the bottom roller ball in order to effect movement of a cursor on a computer monitor screen. (Meriaz para. 0007). In other words, only the trackball or the bottom roller ball, but not both, can be active at any given time.

In the present case, if the bottom roller ball aspect of Meriaz is added to the Armstrong device (as alleged in the Office Action), then such a combined device would only provide one output (from either the roller ball from Meriaz or the trackball of Armstrong). Because of this

shortcoming, the alleged combination of Meriaz and Armstrong fails to teach both “an outgoing displacement signal” and a “second outgoing signal,” as recited in claim 1.

The Advisory Action did not consider Applicant’s position persuasive since the claim “does not call for outputting the two signals at the same time.” (Advisory Action, continuation sheet). Applicant respectfully disagrees with the position set forth in the Action, but has nonetheless provided the foregoing amendment to further clarify claim 1 and to expedite prosecution of the present application. In particular, claim 1 now recites “signal circuitry being configured to permit the production of the outgoing displacement signal and the second outgoing signal simultaneously.” Assuming *arguendo* that Meriaz produces two signals, claim 1 remains distinguishable since such signals are not produced “simultaneously” as called for in this claim. For at least these reasons, claim 1 is not obvious over Armstrong in view of Meriaz

Armstrong teaches away from the mouse device of Meriaz

Applicant’s last response also provided comments relating to Armstrong teaching away from the mouse device of Meriaz. The Examiner disagrees with this position by indicating that Armstrong “combines his own invention with known elements in the prior art.” (Advisory Action, continuation sheet). The Examiner also cited to Figures 8-10 of Armstrong. It appears that the Advisory Action has the position that Figures 8-10 somehow relate to a mouse device, such as that which is disclosed in Meriaz. Applicant respectfully disagrees.

Applicant’s review of these figures finds that none of these figures relate to a mouse device as alleged in the Advisory Action. In particular, Fig. 8 relates to a housing that is structured to rest upon a support surface such as a table or desk. (Armstrong col. 12, lines 9-11). The housing of Fig. 8 is most definitely not a mouse device as alleged by the Advisory Action since, in Armstrong’s own words, the unit of Fig. 8 is used “to replace a typical mouse.” (Armstrong col. 12, line 13).

Fig. 9 is similarly deficient since it relates to a “remote control” device. Armstrong provides no indication that Fig. 9 includes functionality of a mouse device. Lastly, Fig. 10 shows carriage 14 and trackball 12 housed in a conventional computer keyboard 140. Clearly, keyboard 140 does not function as a mouse device, and there is no such teaching in Armstrong to that effect.

This brings us back to Applicant's position with regard to Armstrong. In particular, the whole point of the housing of Armstrong is "to replace a typical mouse." (Armstrong col. 12, line 13) (emphasis added). Armstrong emphasizes this point by clearly discrediting the conventional mouse device of Chang (U.S. 5,298,919), which again is strikingly similar to that of Meriaz. One of ordinary skill upon reading the Armstrong reference would be led in a direction in which a conventional mouse would be replaced using the assorted teachings of Armstrong. This is a classic case of teaching away. The law is clear that a reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the Applicant. See *In re Haruna*, 249 F.3d 1327, 1335, 58 USPQ2d 1517, 1522 (Fed. Cir. 2001). It is a well-established principle that "[i]t is improper to combine references where the references teach away from their combination." MPEP § 2145 (citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)).

In the present application, Armstrong has clearly discounted using the mouse device of Meriaz. By denouncing any association with a conventional mouse (Meriaz), such comments represent a teaching away from the combination of Armstrong and Meriaz. In addition, the various housings of Figs. 8-10 in Armstrong are irrelevant since they have nothing to do with a mouse device.

For at least these reasons, Applicant submits that it would not have been obvious to combine the teachings of Armstrong and Meriaz in the manner alleged to arrive at the invention recited in claim 1. Accordingly, claim 1 is therefore believed to be patentable. Independent claim 15 includes language similar to that of claim 1, and thus, is believed to be patentable for reasons similar to those discussed with regard to claim 1. The rejected dependent claims are also believed to be patentable at least by virtue of their respective dependence on the patentable independent claims.

Dependent claim 25

Claim 25 recites "said rotation sensor detects at least one polarization component." The Advisory Action indicated that such a polarization component is an inherent feature of electromagnetic and magnetic sensors. Applicant respectfully disagrees and is unaware of any authority which sets forth such a position. In addition, Applicant has reviewed a number of prior art references, including those cited in the IDS and the various patents referred in the Office

Actions of the present application. None of these references teach, suggest, or even mention this polarization feature. In view of the foregoing, Applicant respectfully requests that the Examiner provide documentary evidence in the next office action if the rejection to the identified claims is to be maintained. (MPEP § 2144.3[C]; see also 37 CFR § 1.104(c)(2)).

Dependent claim 29

Claim 29 recites “wherein said displacement sensor comprises a pressure sensor configured to generate the displacement sensor signal as a non-binary signal.”

The Advisory Action indicated that the simple switch of Armstrong functions as a pressure sensor, sensing in one of two states (on and off). The present amendment of claim 29 establishes that this claim relates to a “non-binary signal,” which clearly distinguishes over the binary state of Armstrong. Accordingly, dependent claim 29 is believed patentable for this additional reason.

Claim 26 is believed patentable at least by virtue of its dependency on patentable claim 15.

CONCLUSION

In view of the above, Applicant submits that the currently pending claims are in condition for allowance. However, should there remain any outstanding issues, it is respectfully requested that the Examiner telephone the undersigned so that such issues may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fees which may be required in this application to deposit account No. 06-1135.

Address all correspondence to:
FITCH, EVEN, TABIN & FLANNERY
120 So. LaSalle Street, Ste. 1600
Chicago, IL 60603

Direct telephone inquiries to:
Jeffrey J. Lotspeich
(858) 587-7652
San Diego, California Office of
FITCH, EVEN, TABIN & FLANNERY

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

/Jeffrey J. Lotspeich/

Jeffrey J. Lotspeich
Registration No. 45,737
Attorney for Applicant

Date: October 20, 2008